

REMARKS

The Final Office Action mailed October 24, 2008 has been carefully considered. Within the Office Action Claims 1-3, 6-16, 19-43, 46-53 and 55 have been rejected. Applicants have amended Claims 1, 2, 16, 29, 30 and 42. Reconsideration of the amendments and remarks is respectfully requested.

Rejections Pursuant to 35 U.S.C. § 112, First paragraph

In the Office Action, Claims 1, 2, 16, 30, and 42 were rejected as allegedly failing to comply with the written description requirement. Claims 1, 2, 16, 30 and 42 have been amended to overcome the rejection. Withdrawal of the rejection is respectfully requested.

Rejections Pursuant to 35 U.S.C. § 112, second paragraph

In the Office Action, Claim 16 was rejected as allegedly being indefinite. Claim 16 has been amended to overcome the rejection. Withdrawal of the rejection is respectfully requested.

Rejection under U.S.C. § 102

Claims 29, 32, 35 and 37 stand rejected as being allegedly anticipated under 35 USC 102(b) over United States Pat No. 7,210,458 to Wendorff. The rejection is respectfully traversed.

Under 35 USC 102(b), a claim is anticipated only if each and every element/limitation is expressly or inherently disclosed in a single reference.

Wendorff discloses a mobile phone having a body with a second member 210 slidably moveable within a groove of the body. A first member 180 has numeral keys on an outer surface and a half of a keyboard on an inner surface. The second member has the remaining half of the

keyboard on its exposed surface. The first member is pivotably connected to the second member, whereby the first member is opened with respect to the second member to expose both halves of the keyboard. Upon the first member being opened, the first and second members are then slid laterally along the groove of the body to center the keyboard with respect to the body to allow the user to use the keyboard. As expressly taught in Wendorff, the first member is pivotably opened with respect to the second member and is thus not pivotably attached to the body itself.

In contrast, Claim 29 recites *inter alia*, “a third body . . . wherein said third body is pivotably attached to said second body about one hinge axis to an open position to reveal said first and second portions to allow only game play using said dedicated controls.” This specific limitation is not expressly or inherently disclosed in Wendorff. In addition, Wendorff does not inherently disclose the first member being pivotably attached to the second member, because doing so would destroy the novelty surrounding the Wendorff, which is that the device has the slideable feature that centers the keyboard with respect to the device’s body. In other words, Wendorff specifically requires that the first member be pivotably attached to the second member and not the body itself. This is expressly taught in Wendorff where it is stated, “the first member 180 and the second member 210 are coupled along the connecting edges 206, 236 via hinge 240, which provides relative motion between the members 18, 210.” (Wendorff, Col. 3, Lines 1-4). Considering that Wendorff does not expressly or inherently disclose a third body pivotably attached to the second body, Claim 29 is distinguishable over Wendorff. For at least these reasons, Claim 29 is in condition for allowance.

Rejection under U.S.C. § 103

Claims 1, 6, 9, 11, and 13-15 stand rejected as being allegedly obvious over Wendorff in view of United States Pat No. 7,130,669 to Moon and further in view of U.S. Patent Publication No. 200070325 to Wang (hereinafter "Wang"). Claims 16, 19 and 22-25 stand rejected as being allegedly obvious over Wendorff in view of Uchikura and further in view of Iizuka. Claims 41, 46, 49, and 51-53 stand rejected as being allegedly obvious over Wendorff in view of Moon. These rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

In determining obviousness four factual inquiries must be looked into in regards to determining obviousness. These are determining the scope and content of the prior art; ascertaining the differences between the prior art and the claims in issue; resolving the level of ordinary skill in the pertinent art; and evaluating evidence of secondary consideration. Graham v. John Deere, 383 U.S. 1 (1966); KSR Int'l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007) ("Often, it will be necessary . . . to look into related teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit.**") (emphasis added).

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fed. Cir. 1983). Thus, when considering the whole prior art reference its entirety, portions that would lead away from the claimed invention must be considered. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983), See M.P.E.P. 2141.02. Thus, it is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731 (Fed. Cir. 1983).

Applicant's specification describes an embodiment in which the mobile device includes gaming controls in the recess of the first portion as well as on the facing side of the second portion of the third body. In particular to example embodiments shown in Figures 2B and 2C, Applicants describe that dedicated gaming controls, which are controls which are used only for gaming, are incorporated into the device to allow the user to be involved in a richer gaming experience.

Claim 1 recites *inter alia* a third body including a number pad an is pivotally attached to the second body. As discussed above, Wendorff does not disclose that the third body is pivotably attached to the second body, but is instead attached to the moveable second portion 210. For at least the reasons, the combination of references do teach or suggest each and every element/limitation of Claim 1. Accordingly, a *prima facie* case of obviousness has not been established and allowance of Claim 1 is respectfully requested.

Regarding Claim 16, Claim 16 recites *inter alia* third body being pivotally attached to said second body and configured to move between an open position and a closed position. As stated above, Wendorff does not disclose that the third body is pivotably attached to the second body, but is instead attached to the moveable second portion 210. For at least the reasons, the

combination of references do teach or suggest each and every element/limitation of Claim 16. Accordingly, a *prima facie* case of obviousness has not been established and allowance of Claim 16 is respectfully requested.

Regarding Claim 41, Claim 41 recites *inter alia* a third body pivotally coupled to said second body to pivot about a second hinge axis extending perpendicular to said first hinge axis. As stated above, Wendorff does not disclose that the third body is pivotably attached to the second body, but is instead attached to the moveable second portion 210. For at least the reasons, the combination of references do teach or suggest each and every element/limitation of Claim 41. Accordingly, a *prima facie* case of obviousness has not been established and allowance of Claim 41 is respectfully requested.

As discussed above, none of the cited references teach or suggest each and every element/limitation in Claims 1, 16, 29 and 41. Accordingly, a *prima facie* of obviousness cannot be set forth with the cited references. Accordingly, withdrawal of the rejection and allowance of Claims 1, 16, 29 and 41 is respectfully requested.

Dependent Claims

Considering the dependent claims include all of the features of the independent claims from which they depend, the dependent claims are patentable to the extent that the independent claims are patentable. As a result, Applicants respectfully contend that a *prima facie* case of obviousness is not present with respect to the dependent claims for the reasons set forth above with respect to the independent claims.

Conclusion

It is believed that this reply places the above-identified patent application into condition for allowance. Early favorable consideration of this reply is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-3557.

Respectfully submitted,

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